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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,319	04/20/2001	Tomoya Saeki	Q64153	1014

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER
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WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/838,319

Applicant(s)

SAEKI, TOMOYA

Examiner

Jalatee Worjloh

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-42 have been examined.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: typographical error, change "step 2" to "step S2" (see pg. 13, line 9).

Appropriate correction is required.

#### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 5 of fig. 4 (see pg.15, line 11). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-17, 19-31, and 33-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2003/0204610 to Howard et al. in view of US Publication No. 2003/0212642 to Weller et al.

Art Unit: 3621

Referring to claims 1,15 and 29, Howard et al. disclose the system has a database for storing at least personal authentication data required for said personal authentication and previously registered, and data required to receive various services (see paragraphs [0018] and [0029]), said authentication server has a function of collating said authentication information input from said authentication terminal via said communication terminal, against said personal authentication data stored in said database, said authentication terminal when the client is authenticated during said identification, and a function of providing, registering, and managing personal data registered beforehand in said database based on a request forms aid authentication terminal when the client is authenticated during said identification and periodically communicating a collation history, a personal data usage history, and a charge process history, i.e. cookie (see abstract, lines 11-14,21-25). Howard et al. do not expressly disclose a database storing settling account information required to process charges or a function of processing charges based on said settling account information registered in said database based on a request. Weller et al. disclose a database for storing settling account information required to process charges and a function of processing charges based on said settling account information registered in said database based on a request (see paragraphs [0036] and [0039]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Howard to include database for storing settling account information required to process charges and a function of processing charges based on said settling account information registered in said database based on a request. One of ordinary skill in the art would have been motivated to do this because the database can be used by the

Art Unit: 3621

authentication service to verify the identity of the client of the authentication terminal; thus, reducing fraud and disputes (see paragraphs [0005] and [0039]).

Referring to claims 2, 16 and 30, Howard et al. disclose the system wherein said authentication server includes a function of communicating permission for said various services based on a request from said authentication terminal when the client is authenticated during said identification (see paragraphs [0019] and [0032]).

Referring to claims 3, 17 and 31, Howard et al. disclose the system wherein said personal authentication data are at least one of the client's fingerprint, the client's voiceprint, the client's iris pattern, and a preset password (see paragraph [0029]).

Referring to claims 5, 19 and 33, Howard et al. disclose the function of communicating said collation history, said personal data usage history, and said charge process history is configured to show these information on a home page (see [0044]).

Referring to claims 6, 20 and 34, Howard et al. disclose the system wherein only previously registered clients are allowed to view said home page (see paragraph [0029]).

Referring to claims 7, 21 and 35, Howard et al. disclose a personal authentication system including an authentication terminal. Howard et al. do not expressly disclose the authentication terminal is installed in a store and is configured to request said authentication server to execute said identification when at least one of a commodity and a service is to be provided and to request said authentication server to pay a consideration for the provided commodity and service from said settling account when the client is authenticate during said identification. Wheeler et al. disclose the authentication terminal is installed in a store and is configured to request said authentication server to execute said identification when at least one of a commodity and a

Art Unit: 3621

service is to be provided and to request said authentication server to pay a consideration for the provided commodity and service from said settling account when the client is authenticate during said identification (see [0032], and [0033]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Howard et al. to include the authentication terminal at a store. One of ordinary skill in the art would have been motivated to do this because it performs verification; thus, reducing fraud and disputes (see [0005]).

Referring to claims 8-14, 22-28 and 36-42, Howard et al. discloses a personal authentication system including an authentication terminal (see claim 1 above). Howard et al. do not expressly disclose the authentication terminal installed at a ticket gate of a public transportation facility, hospital clerk's window, government officer's window, in various service-providing facilities, an entrance or exit of a facility, a window where a certificate is issued or added to a public telephone, configured to request said authentication server to execute said identification and pay for the services from said settling account. Wheeler et al. disclose the authentication terminal installed at a ticket gate of a public transportation facility, hospital clerk's window, government officer's window, in various service-providing facilities, an entrance or exit of a facility, a window where a certificate is issued and added to a public telephone, configured to request said authentication server to execute said identification and pay for the services from said settling account (see paragraphs [0032] and [0033]). Notice, "PAS can also be used in aspects of **retail banking** such as debit cards, purchase cards, stored value cards, as well as wholesale banking, **the medical business**, the insurance business, the brokerage business, etc. ID cards can also used with PAS. For example, **AAA** may use PAS to authenticate the identity

Art Unit: 3621

of its customer, or **telephone card company** can use PAS to authenticate the identity of the user of a specific card” (see paragraph [0033], lines 20-27). Thus, this implies that the authentication terminal may be installed in any facility including a ticket gate of a public transportation facility, a public telephone, hospital clerk’s window, a government officer’s window, an entrance or exit of a facility, a window where a certificate is issued and in various service-providing facilities. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Howard et al. to include the authentication terminal installed at a ticket gate of a public transportation facility, hospital clerk’s window, government officer’s window, an entrance or exit of a facility, a window where a certificate is issued, in various service-providing facilities or added to a public telephone, configured to request said authentication server to execute said identification and pay for the services from said settling account. One of ordinary skill in the art would have been motivated to do this because it performs verification; thus, reducing fraud and disputes (see [0005]).

6. Claims 4, 18 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. as applied to claims 1, 15 and 29 respectively above, and further in view of U.S. Publication No. 2002/0120496 to Scroggie et al.

Howard et al. disclose communicating said collation history, said personal data usage history, and said charge process history (see Abstract, lines 11-14, 21-25). Howard et al. do not expressly disclose the function of communicating is configured to communicate this information by electronic mail. Scroggie et al. disclose transmitting email messages to consumers based on purchase history information stored in the consumers’ database (see paragraph [0110]). Notice,

Art Unit: 3621

the examiner interprets the purchase history information as "collation history, personal data usage history and charge process history". At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Howard et al. such that the function of communicating is configured to communicate this information by electronic mail. One of ordinary skill in the art would have been motivated to do this because it an easy and quick method of transmitting data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

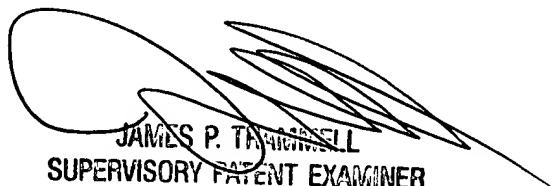
Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks  
PO Box 1450  
Alexandria, VA 22313-1450***

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

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December 23, 2003

  
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